

REMARKS

The Examiner's Answer¹ sets forth new grounds of rejection of claims 1-6, 8-10, and 12-30 under 35 U.S.C. § 101. In addition, claims 31-36, 38-45, and 47 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,081,611 to Linford et al. ("Linford"), and claims 1-30, 37, 46, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Linford in view of the archived Internet website of Proactiv² ("Proactiv").

By this Reply, Applicants have amended claims 1, 6, 8, 11, and 22. The amendments are relevant to the new ground of rejection, and introduce no new matter. Claims 1-48 are currently pending. Based on the foregoing amendments and the following remarks, Applicants respectfully traverse the rejections of the pending claims.

I. New Ground of Rejection of Claims 1-6, 8-10, and 12-30 Under 35 U.S.C. § 101

The Examiner's Answer rejects claims 1-6, 8-10, and 12-30 based on a new ground of rejection under 35 U.S.C. § 101 because "applicant's method steps [purportedly] fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class." Examiner's Answer at 5. Applicants respectfully submit that this claim rejection should be withdrawn.

"[A]n applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an

¹ The Examiner's Answer contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Examiner's Answer.

² http://web.archive.org/web/20010521145551rn_1/www.proactiv.com/index.php

article.” *In re Bilski*, slip op. at 24 (Fed. Cir. 2008). Claim 1 recites, among other things, “maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition,” and is thus tied to a particular machine.

In addition, Applicants have amended claims 1, 6, 8, 11, and 22. Amended independent claim 1 recites a “computer-implemented method . . . comprising [among other things] receiving, in a memory . . . ; generating, using a processor . . . ; and outputting, to a device” Applicants submit that amended independent claim 1 is tied to a particular machine, and therefore conforms with the recent Federal Circuit decision in *In re Bilski*. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection of claims 1-6, 8-10, and 12-30.

II. The § 102(b) Rejection of Claims 31-36, 38-45, and 47 Based on Linford

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). A rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P § 2131; see *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) and *Net Money/IN, Inc. v. Verisign, Inc.*, No. 2007-1565 (Fed. Cir. Oct. 20, 2008) at 15-18.

A. Claim 31

Independent claim 31 recites, among other things, “a database for storing information on how use of at least one beauty product affects evolution of [an] external body condition,” and “a processor for modifying [a] representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” In the Examiner’s Answer at page 5, the Examiner asserts that Linford discloses the recited subject matter at column 5, lines 30-57. Applicants respectfully disagree.

Linford discloses “[a] processing unit . . . controlled by an operating system [and a] memory . . . connected to the processing unit” and that the memory “generally comprises . . . random access memory (RAM), read only memory (ROM), magnetic storage media such as a hard drive, floppy disk, or magnetic tape.” Linford, col. 5, lines 30-36. Linford also discloses “an image capture board . . . coupled to the processing unit . . . , a monitor . . . , video source . . . , and printer.” Linford, col. 5, lines 44-48. However, the Linford reference fails to even mention a “database” or disclose any component for storing information on how use of at least one beauty product affects evolution of an external body condition. Thus, Linford fails to disclose “a database for storing information on how use of at least one beauty product affects evolution of [an] external body condition,” as recited in independent claim 31.

In the Final Office Action³ mailed April 15, 2008 (“Final Office Action”) at page 15, and again in the Examiner’s Answer at 17-18, the Examiner asserts, without citing any authority, that “a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention from the prior art.” Applicants submit that, regardless of whether the Examiner’s assertion has any merit, both the Final Office Action and the Examiner’s Answer fail to address the structural differences between claim 1 and Linford. As explained above, the Linford reference fails to mention a “database” or disclose any component for storing information on how use of at least one beauty product affects evolution of an external body condition. This is because Linford is directed to “an aesthetic imaging system . . . for use in editing digital images” that enables a physician to manually edit a preoperative image during a consultation with a patient in attendance. Linford, Abstract and col. 1, lines 51-53. A physician relies on his own knowledge of how a cosmetic surgery would affect a preoperative image, and there is no disclosure of any modification of the image being based on information stored in a database. This is at least one example of a structural difference between the claimed invention and Linford.

In the Final Office Action at page 7 and in the Examiner’s Answer at 10, with respect to claims 1 and 48, the Examiner even admits that “Linford . . . fails to disclose: maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition.” The Examiner’s own admission confirms that

³ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

Linford does not disclose “a database for storing information on how use of at least one beauty product affects evolution of [an] external body condition,” as recited in independent claim 31.

In addition, because Linford does not disclose a database that stores information on how use of at least one beauty product would affect evolution of an external body condition, Linford fails to disclose “a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 31. As explained above, Linford enables a physician to manually edit a preoperative image during a consultation with a patient in attendance. A system for handling manual editing of a preoperative image is not the same as “a processor [that], based on information contained in the database, . . . generate[s] at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 31.

In the Examiner’s Answer at 18, the Examiner asserts that “in order for the user to manipulate the image to the desired outcome, the system must require data that instructs the system on how to carry out or perform the manipulation desired by the user.” The Examiner’s assertion, however, appears to overlook the fact that “a database for storing information on how use of at least one beauty product affects evolution of [an] external body condition” is not inherently described in Linford.

As M.P.E.P. § 2112 makes clear:

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (internal citations omitted).

In addition, M.P.E.P. § 2112 states:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. (internal citations omitted).

The Examiner’s Answer fails to provide sufficient evidence from Linford, or any extrinsic evidence, that the subject matter of claim 31 is necessarily present in the reference, or that a database is necessarily present in a system such as the system of Linford. The Examiner’s Answer also fails to present sufficient factual basis and technical reasoning to demonstrate inherency. For example, a system having instructions on how to carry out or perform the manipulation desired by a user does not necessarily include a database. The instructions are not necessarily stored in a database, and may be stored in a file system. In addition, the instructions do not necessarily require a database, and may be performed without a database in the system. For example, a drawing software that carries out user’s desired edit inputs can run on a personal computer without the need of a database in the computer. Consequently, the Examiner cannot properly infer that a database is inherently included in a system having instructions on how to carry out or perform the manipulation desired

by a user, such as in the system of Linford. Moreover, even assuming that a database is inherently included in the system of Linford, Linford fails to teach or suggest the existence of any “information on how use of at least one beauty product affects evolution of [an] external body condition” in its system, as recited in independent claim 31.

In the Examiner’s Answer at 18-19, the Examiner also asserts, without citing any authority, that “the data stored in the system of claims 31, 32, and 47 are nonfunctional descriptive subject matter since the type of data adds little, if anything, to the claim’s structure, and, thus, does not serve as limitation on the claims to distinguish over the prior art.”

Applicants fail to see how the “functional and nonfunctional descriptive subject matter” test typically reserved for determining statutory subject matter under 35 U.S.C. § 101 is relevant in determining patentability under 35 U.S.C. § 102. M.P.E.P. § 2143.03, instead, clearly provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In addition, a rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d at 587, 172 USPQ at 526. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson*, 868 F.2d at 1236, 9 USPQ2d at 1920. The Examiner’s position, which completely ignores certain words in a claim in judging patentability under § 102 is neither supported by the M.P.E.P. nor by case law.

For at least the above reasons, Linford does not support the § 102(b) rejection of independent claim 31. Therefore, the § 102(b) rejection of independent claim 31 based on Linford should be withdrawn.

B. Claim 32

Independent claim 32, although of different scope, recites subject matter that is similar to the subject matter recited in independent claim 31. For example, independent claim 32 recites, among other things, “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” As explained above with respect to independent claim 31, Linford fails to disclose “a database [that] stor[es] information on how use of at least one beauty product affects evolution of [an] external body condition,” and “a processor [that], based on information contained in the database, . . . generate[s] at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” Thus, Linford also fails to disclose “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 32.

For at least the above reasons, the § 102(b) rejection of independent claim 32 based on Linford should be withdrawn.

C. Claim 47

Independent claim 47, although of different scope, recites subject matter that is similar to the subject matter recited in independent claim 31. For example, independent claim 47 recites, among other things, “a database containing information on how use of at least one beauty product affects evolution of the external body condition,” and “a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product.” As explained above with respect to independent claim 31, Linford fails to disclose “a database [that] stor[es] information on how use of at least one beauty product affects evolution of [an] external body condition,” and “a processor [that] modif[ies a] representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” Thus, Linford also fails to disclose “a database containing information on how use of at least one beauty product affects evolution of the external body condition,” and “a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product,” as recited in independent claim 47.

Independent claim 47 recites further distinctions from Linford. For example, independent claim 47 recites “a secondary storage storing a mesh frame representative of at least one part of human anatomy.” In the Final Office Action at page 5 and again in the Examiner’s Answer at 8, the Examiner asserts that Linford discloses the recited subject matter in column 5, lines 30-57. Applicants respectfully disagree.

As explained above with respect to independent claim 31, Linford discloses “[a] processing unit . . . controlled by an operating system [and a] memory . . . connected to the processing unit” and that the memory “generally comprises . . . random access memory (RAM), read only memory (ROM), magnetic storage media such as a hard drive, floppy disk, or magnetic tape.” Linford, col. 5, lines 30-36. Linford also discloses “an image capture board . . . coupled to the processing unit . . . , a monitor . . . , video source . . . , and printer.” Linford, col. 5, lines 44-48. However, the Linford reference fails to even mention “a mesh frame representative” or disclose any component for storing “a mesh frame representative of at least one part of human anatomy,” as recited in independent claim 47. Thus, Linford fails to disclose “a secondary storage storing a mesh frame representative of at least one part of human anatomy,” as recited in independent claim 47.

In the Examiner’s Answer at 19, the Examiner asserts that Linford “discloses utilizing 3D imaging in order to better represent the prognosis.” Despite the assertion, nowhere does Linford disclose utilizing 3D imaging in order to better represent the prognosis.” See, FIGS. 6, 7A-E, 8A-E, 9D-G, 11, 14A-14D, 15A-C, 16, 17, 18A-C, 19A-B, and 20. In addition, Linford at col. 18, lines 41-52, merely describes a rotating tool, which enables a user to select a rotating axis for rotating a section of a 2-D image.

Even assuming *arguendo*, that Linford discloses “utilizing 3D imaging in order to better represent the prognosis,” as asserted by the Examiner, the assertion appears to overlook the fact that “a secondary storage storing a mesh frame representative of at least one part of human anatomy” is not inherently described in Linford. The Examiner’s Answer fails to provide sufficient evidence from Linford, or any extrinsic evidence, that the subject matter of claim 47 is necessarily present in the reference, or that “a secondary storage storing a mesh frame representative of at least one part of human anatomy” is necessarily present in the system of Linford. The Examiner’s Answer also fails to present a sufficient factual basis and technical reasoning to demonstrate inherency. For example, a system may utilize 3D imaging in order to better represent the prognosis, without any “secondary storage storing a mesh frame representative of at least one part of human anatomy,” as recited in independent claim 47. The mere fact that a system utilizes 3D imaging in order to better represent the prognosis does not necessarily make a secondary storage present in the system. Consequently, “a secondary storage storing a mesh frame representative of at least one part of human anatomy” is not inherently included in the system of Linford.

In the Examiner’s Answer at 19, the Examiner also asserts, without citing any authority, that “the type of data adds little, if anything, to the claim’s structure, and thus does not serve as a limitation on the claims to distinguish over the prior art.” As explained above with respect to independent claim 31, M.P.E.P. § 2143.03 clearly provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” The Examiner’s position, which completely ignores

certain words in a claim in judging patentability under § 102 is neither supported by the M.P.E.P. nor by the case law.

For at least the above reasons, the § 102(b) rejection of independent claim 47 based on Linford should be withdrawn.

D. Claims 33-36 and 38-45

Claims 33-36 and 38-45 depend from independent claim 32. Thus, claims 33-36 and 38-45 incorporate the elements that are missing from Linford, as discussed above. Accordingly, the rejection of dependent claims 33-36 and 38-45 under 35 U.S.C. § 102(b) should be withdrawn.

III. The § 103(a) Rejection of Claims 1-30, 37, 46, and 48 Based on Linford and Proactiv

The rejection of claims 1-30, 37, 46, and 48 under 35 U.S.C. § 103(a) should be reversed because a case for *prima facie* obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether

the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

A. Claim 1

Independent claim 1 recites, among other things, “maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “generating, using a processor, based on both [a] received representation and the information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.”

As explained above, Linford is directed to “an aesthetic imaging system . . . for use in editing digital images” that enables a physician to manually edit a preoperative image during a consultation with a patient in attendance. Linford, Abstract and col. 1, lines 51-53. A physician relies on his own knowledge of how a cosmetic surgery would affect a preoperative image, and there is no disclosure or suggestion of any modification of the image being based on information stored in a database. In the Final Office Action at 7, the Examiner thus correctly observes that Linford fails to disclose “maintaining, in a

database, information of how use of at least one beauty product affects evolution of the external body condition.” In addition, because Linford does not teach “maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” Linford does not also teach or suggest “generating, using a processor, based on both the received representation and the information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 1 (emphasis added).

Proactiv fails to cure the deficiencies of Linford. In the Final Office Action at page 7, and again in the Examiner’s Answer at 10, the Examiner asserts that “Proactiv [purportedly] discloses how the use of a beauty product affects the evolution of an external body condition, wherein the information is stored in a database.” (emphasis omitted). Applicants respectfully disagree and submit that Proactiv shows web pages containing text and graphic describing beauty products. The pages, by themselves, do not teach or suggest that “the information is stored in a database,” as asserted by the Examiner.

Further, even assuming, *arguendo*, that Proactiv teaches that “the information is stored in a database,” as asserted by the Examiner, nothing in Linford or Proactiv teaches or suggests that the information in a database is used, in any way, to generate at least one prognosis reflecting predicted changes in an external body condition after use of one or more beauty product. The information in text (e.g., sentences in paragraphs), as shown in web pages of Proactiv, is not structured in any way that would

appear to be used in generating at least one prognosis reflecting predicted changes in an external body condition after use of one or more beauty products.

In the Final Office Action at 15, and again in the Examiner's Answer at 15, the Examiner asserts that "Linford does disclose that information stored in a database is used to create the post-operative image," without citing any basis for the Examiner's assertion. (Emphasis omitted.) Applicants respectfully disagree and submit that the Examiner mischaracterizes Linford because the Linford reference does not even mention a "database" or disclose any maintaining of information on how use of at least one beauty product affects evolution of an external body condition.

In the Examiner's Answer at 21, the Examiner further asserts that claim 1 recites "a combination which only unite old elements with no change in their respective functions and which yield predictable results." "Thus, the claimed subject matter likely would have been obvious under *KSR*. In addition, neither the appellant's specification nor the appellant's arguments present any evidence that modifying Linford with selected elements of Proactiv was uniquely challenging or difficult for one of ordinary skilled in the art." Examiner's Answer at 21. Applicants cannot disagree more.

The Examiner is essentially, in a clearly improper hindsight fashion, arguing that an image editing tool based on a user input and a website can somehow be combined to "generat[e], using a processor, based on both [a] received representation and . . . information" contained in the website, "at least one prognosis reflecting predicted changes in [an] external body condition after use of . . . at least one beauty product," as recited in amended independent claim 1. Applicants submit that the function of a website is presenting a web page, and the function of a image editing tool based on a

user input is editing an image in response to an input from a user. Without changing their respective functions, the web page, maintained in the website of Proactiv, cannot function as a user input, in the image editing tool of Linford, to “generat[e] . . . at least one prognosis reflecting predicted changes in [an] external body condition after use of . . . at least one beauty product,” as recited in amended independent claim 1.

Moreover, the Supreme Court in *KSR* emphasized that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). The Federal Circuit has also stated that, even after the Supreme Court’s decision in *KSR*, “a flexible [teaching, suggestion, and motivation] test remains the primary guarantor against a non-statutory hindsight analysis.” *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1364 (Fed. Cir. 2008). *KSR* does not lift the Examiner’s burden of establishing a *prima facie* case of obviousness, and the Examiner’s reliance on *KSR*, especially in combination with the Examiner’s improper hindsight reasoning, is clearly erroneous.

Furthermore, neither the M.P.E.P. nor the case law requires Applicants to present any evidence that modifying Linford with the selected elements of Proactiv was uniquely challenging or difficult for one of ordinary skill in the art. Because the Examiner has not properly established a case for *prima facie* obviousness, Applicants are under no obligation to present such evidence. Negative inference cannot be taken from the absence of such evidence, and the absence of such evidence cannot be in any way used to establish a *prima facie* case of obviousness.

In view of the above-noted deficiencies and mischaracterizations of the Linford and Proactiv references and improper reliance on the case law, the Final Office Action and the Examiner Answer have neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of amended independent claim 1. Therefore, the Final Office Action and the Examiner's Answer have failed to clearly articulate a reason why claim 1 would have been purportedly obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claim 1, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

B. Claim 48

Independent claim 48, although of different scope, recites subject matter that is similar to the subject matter recited in independent claim 1. For example, independent claim 48 recites, among other things, "maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition," and "generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product." As explained above with respect to independent claim 1, a *prima facie* case of obviousness has not been established with respect to independent claim 1. For at least reasons similar to the reasons set forth above with respect to independent claim 1, a *prima facie* case of obviousness has not established with respect to independent claim 48, and therefore, Linford and Proactiv, taken alone or in combination, fail to support the rejection under

35 U.S.C. § 103(a). Accordingly, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

C. Claims 2-30

Claims 2-30 depend from independent claim 1. Claims 2-30 are allowable at least by virtue of their dependence from an allowable independent claim. Accordingly, the rejection of dependent claims 2-30 under 35 U.S.C. § 103(a) should be withdrawn.

In addition, the dependent claims recite further distinctions over the cited references.

i. Claims 17-19

Dependent claim 17 recites, among other things, a “beauty product [that] is chosen from skin products, hair products, and nail products.” Dependent claim 18 recites, among other things, a “beauty product [that] comprises a skin product chosen from moisturizers, wrinkle removers, and exfoliates.” Dependent claim 19 recites, among other things, a “hair product chosen from a conditioner and a shampoo.” In the Final Office Action at page 11, the Examiner admits that the “combination of Linford and Proactiv fails [to] disclos[e] wherein the beauty product is chosen from skin products, hair products, and nail products, moisturizers, wrinkle removers, and hair product chosen from a conditioner and a shampoo.” (emphasis omitted). The Examiner, however, alleges, in a clearly improper hindsight fashion that “it would have been obvious to one having ordinary skill in the art that a variety of beauty products can be used and all would produce the same predictable result of generating a prognosis showing the effects of using a beauty product.” The hindsight reasons identified by the Examiner are, at best, conjectural and not supported by any findings.

For these additional reasons, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

ii. Claim 25

Dependent claim 25 recites, among other things, “rendering [a] prognosis on a three-dimensional mesh image.” Linford discloses that “another view option provided to the user in the aesthetic imaging system is an Emboss option.” Linford, col. 25, lines 19-20. “The emboss option displays an image that is *similar* to an etching made of a three-dimensional raised surface.” Linford, col. 25, lines 25-27 (emphasis added). Thus, although “similar,” the emboss option still portrays an image as a two dimensional image, “with the depth of the raised surface indicated by a darker shade of gray.” As shown in FIGS. 6, 7A-E, 8A-E, 9D-G, 11, 14A-D, 15A-C, 16, 17, 18A-C, 19, and 20 of Linford, none of the images is a three-dimensional mesh image. For these additional reasons, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

D. Claims 37 and 46

Claims 37 and 46 depend from independent claim 32. As discussed above with respect to independent claim 32, Linford fails to disclose “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 32. Proactiv also does not disclose or suggest these features recited in claim 32. As explained above with respect to independent claim 1, Proactiv fails to teach or suggest “maintaining, in a database, information of how use of

at least one beauty product affects evolution of [an] external body condition,” and “generating, using a processor, based on both the received representation and the information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 1. Thus, Proactiv also fails to teach or suggest “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 32, and thus fails to cure the deficiencies of Linford. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 37 and 46, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

IV. Conclusion

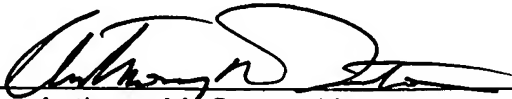
For the reasons set forth above, claims 1-48 are patentable over the cited references.

Please grant any extensions of time required to enter this Reply and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 23, 2008

By: 
Anthony M. Gutowski
Reg. No. 38,742
(202) 408-4000